

REMARKS

This application has been carefully reviewed in light of the Office Action dated May 13, 2009 (“*Office Action*”). In the *Office Action*, the Examiner rejects Claims 1, 3-5, and 7-16. To advance prosecution of this application, Applicants amend Claims 1, 5, 11-12, and 15-16. Applicants do not admit that the amendments are necessary due to the cited references or any of the Examiner’s rejections. Applicants respectfully traverse the rejections and request reconsideration and allowance of all pending claims.

Claim Rejections - 35 U.S.C. § 112

Claims 1, 3-4, and 9-12

The *Office Action* rejects Claims 1, 3-4, and 9-12 under 35 U.S.C. § 112, second paragraph. In particular, the *Office Action* asserts that “it is not clear which steps of the method are performed by a computer.” (*Office Action*, p. 2). Without acquiescing to this assertion, Applicants respectfully submit that Claims 1, 3-4, and 9-12, as amended, are sufficiently definite. For example, amended Claim 1 recites, in part, “generating a comparative analysis of a plurality of educational savings plans...the comparative analysis generated by a computer.” Accordingly, Applicants respectfully submit that these claims, as amended, satisfy the requirements of 35 U.S.C. § 112. Therefore, Applicants respectfully request reconsideration and allowance of amended Claims 1, 3-4, and 9-12.

Claims 11-12 and 15-16

The *Office Action* rejects Claims 11-12 and 15-16 under 35 U.S.C. § 112, second paragraph. In particular, the Office Action asserts that “it is not clear how a report can comprise a lump sum or a monthly savings.” (*Office Action*, p. 3). Without acquiescing to this assertion, Applicants respectfully submit that Claims 11-12 and 15-16, as amended, are sufficiently definite. For example, amended Claim 11 recites, in part, that “said report of said comparative analysis comprises an indication of said monthly savings needed under each of said plurality of educational savings plans.” Accordingly, Applicants respectfully submit that these claims, as amended, satisfy the requirements of 35 U.S.C. § 112. Therefore, Applicants respectfully request reconsideration and allowance of amended Claims 11-12 and 15-16.

Claim Rejections - 35 U.S.C. § 101

The *Office Action* rejects Claims 1, 3-4, and 9-12 under 35 U.S.C. § 101. In particular, the *Office Action* asserts that the claimed invention is directed to non-statutory subject matter because “critical steps...are interpreted to be performed by a human.” (*Office Action*, p. 2). Without acquiescing to this assertion, Applicants respectfully submit that Claims 1, 3-4, and 9-12, as amended, are directed to patentable subject matter. The Federal Circuit recently held that an applicant may show that a claim “satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.” *In re Bilski*, 545 F.3d 943, 961, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008). Claims 1, 3-4, and 9-12, as amended, are tied to one or more machines. For example, amended Claim 1 recites, in part, “generating a comparative analysis of a plurality of educational savings plans...the comparative analysis generated by a computer.” Thus, the method of amended Claim 1 is tied to at least one machine. Accordingly, Claims 1, 3-4, and 9-12, as amended, satisfy the requirements of 35 U.S.C. § 101. Therefore, Applicants respectfully request reconsideration and allowance of Claims 1, 3-4, and 9-12.

Claim Rejections - 35 U.S.C. § 103

The *Office Action* rejects Claims 1, 3-5, and 7-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,424,952 issued to Yinbal (“*Yinbal*”) in view of U.S. Patent No. 6,253,192 issued to Corlett et al. (“*Corlett*”). Applicants respectfully request reconsideration and allowance of Claims 1, 3-5, and 7-16.

The *Yinbal-Corlett* combination fails to support the rejection of amended Claim 1 for at least three reasons. First, the *Yinbal-Corlett* combination fails to disclose, teach, or suggest “outputting a report of the comparative analysis, the report presenting an amount of assets in at least one of the educational savings plans for each year until at least graduation of a student” as recited in amended Claim 1. Second, the *Yinbal-Corlett* combination fails to disclose, teach, or suggest “generating a comparative analysis of a plurality of educational savings plans” as recited in amended Claim 1. Third, the *Yinbal-Corlett* combination fails to disclose, teach, or suggest a “comparative analysis taking into account one or more taxation implications for at least one of the educational savings plans” as recited in amended Claim 1.

First, the *Yinbal-Corlett* combination fails to disclose, teach, or suggest “outputting a report of the comparative analysis, the report presenting an amount of assets in at least one of the educational savings plans for each year until at least graduation of a student” as recited in

amended Claim 1. The *Office Action* relies on *Yinbal* with respect to the “report” recited in Claim 1. (*Office Action*, p. 6). The cited portion of *Yinbal* discloses calculating the present value of future educational costs. (*Yinbal*, col. 9, l. 65 – col. 10, l. 21). Specifically, the cited portion of *Yinbal* states:

The administrator of the present invention system may conduct on-line administration of the customers' on-line activities, conduct calculations of the present value of future educational costs based on the information and selection provided by the customer.

...

The result of the calculation may be delivered back to the customer via the Internet 50.

(*Yinbal*, col. 9, l. 65 – col. 10, l. 21). Thus, *Yinbal* merely discloses calculating the present value of future educational costs and delivering the result to a user. (*Yinbal*, col. 9, l. 65 – col. 10, l. 21). There is nothing in the cited portion of *Yinbal* that discloses, teaches, or suggests a “report” or an “amount of assets in at least one of the educational savings plans for each year until at least graduation of a student” as recited in Claim 1. Thus, *Yinbal* fails to disclose, teach, or suggest “outputting a report of the comparative analysis, the report presenting an amount of assets in at least one of the educational savings plans for each year until at least graduation of a student” as recited in amended Claim 1. *Corlett* fails to cure this deficiency of *Yinbal*. Accordingly, the *Yinbal-Corlett* combination fails to support the rejection of amended Claim 1.

Second, the *Yinbal-Corlett* combination fails to disclose, teach, or suggest “generating a comparative analysis of a plurality of educational savings plans” as recited in amended Claim 1. The *Office Action* admits that *Yinbal* fails to teach this portion of Claim 1. (*Office Action*, p. 7). In addition, *Corlett* does not mention education or educational savings at all, as shown in Applicants’ Response filed on January 26, 2009. Recognizing this deficiency of *Yinbal* and *Corlett*, the *Office Action* asserts that “[t]he feature of generating a comparative analysis of a plurality of plans is old and well known in the art of financial planning.” (*Office Action*, p. 7). The *Office Action* fails to cite any documentary evidence to support this assertion. Accordingly, Applicants respectfully traverse the *Office Action*’s assertion that generating a comparative analysis of a plurality of plans is old and well known. Applicants submit that “the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained.” MPEP § 2144.03(C). If the Examiner is relying on personal knowledge as support for the foregoing assertion, then “the examiner must provide

an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” MPEP § 2144.03(C). Otherwise the rejection must be withdrawn.

Third, the *Yinbal-Corlett* combination fails to disclose, teach, or suggest a “comparative analysis taking into account one or more taxation implications for at least one of the educational savings plans” as recited in amended Claim 1. The *Office Action* admits that *Yinbal* fails to teach this portion of Claim 1, and instead relies upon *Corlett* to cure this deficiency. (*Office Action*, p. 7). The cited portion of *Corlett* discloses a method for calculating income taxes. (*Corlett*, col. 8, ll. 38-44). Specifically, the cited portion of *Corlett* states:

To calculate total income tax for the year, the total entry formula locates the information it needs in the various parts of the model. It knows the entry types required and the areas in the model in which they reside. It then does whatever calculations are necessary to calculate tax according to the tax laws prevailing in the year being processed.

(*Corlett*, col. 8, ll. 38-44) (emphasis added). Thus, *Corlett* merely discloses calculating income taxes. There is nothing in the cited portion of *Corlett* that discloses “educational savings plans” or “taxation implications for at least one of the educational savings plans” as recited in Claim 1. Accordingly, *Corlett* fails to disclose, teach, or suggest a “comparative analysis taking into account one or more taxation implications for at least one of the educational savings plans” as recited in amended Claim 1. Because the *Yinbal-Corlett* combination fails to disclose, teach, or suggest each element of amended Claim 1, the *Office Action* fails to support the rejection. For at least the foregoing reasons, Applicants respectfully request reconsideration and allowance of amended Claim 1.

In rejecting Claim 5, the *Office Action* employs rationale similar to that used to reject Claim 1. Accordingly, for reasons analogous to those stated above with respect to amended Claim 1, Applicants respectfully request reconsideration and allowance of amended Claim 5.

Claims 3-4 and 7-16 depend from independent claims shown above to be allowable. In addition, the *Office Action* improperly relies on Official Notice to reject these claims. For example, the *Office Action* states with respect to Claims 11-12 and 15-16: “official notice is taken that the features of computing monthly savings needed under each of a plurality of savings plans or computing a lump sum saving needed under each of a plurality of savings plans and displaying it to the user is old and well known in the art...Inclusion of these features to the disclosure of *Yinbal* would have helped the participant of the savings plan to choose the option that best fits their preferences and capacity.” (*Office Action*, p. 8).

Applicants respectfully note that the *Office Action* does not cite any evidence to support the foregoing assertion. Accordingly, Applicants traverse the assertion of Official Notice and respectfully submit that “the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained.” MPEP § 2144.03(C). If the Examiner is relying on personal knowledge as support for the foregoing assertion, then “the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” MPEP § 2144.03(C). Otherwise the rejection must be withdrawn. For at least the foregoing reasons, Applicants respectfully request reconsideration and allowance of Claims 3-4 and 7-16.

No Waiver

All of Applicants’ arguments and amendments are without prejudice or disclaimer. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicants are sufficient to overcome the rejections.

CONCLUSION

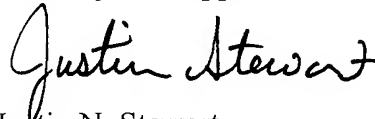
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Justin N. Stewart Attorney for Applicants, at the Examiner's convenience at (214) 953-6755.

Applicants believe that no fees are due; however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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